

REMARKS/ARGUMENTS

In the Amendment filed in the present case on December 10, 2007, Applicants argued that the presently claimed invention is not obvious over Roos (U.S. 6,403,746) or Mottus (U.S. 3,311,597) in combination with Kinker (U.S. 5,696,066) because the cited prior art does not disclose a composition containing an alkyl(meth)acrylate polymer in an amount of at least 5% by weight (see pages 9 and 10 of the December 10, 2007 Amendment). The Office now asserts that Kinker's disclosure of compositions that may contain up to 2% by weight of a polymer render the presently claimed compositions *prima facie* obvious because a composition having from 5-30% by weight of an alkyl(meth)acrylate polymer is close enough to a composition having up to 2% by weight of an alkyl(meth)acrylate polymer such that one of ordinary skill in the art would have expected such compositions to have the same properties (see for example, page 4, second and third full paragraphs; page 7, first full paragraph; and page 10 first full paragraph of the December 10, Office Action). The Office relies on *Titanium Metals Corporation of America* and *In re Kerkhoven* as support for the assertion that the prior art compositions and the claimed compositions would behave in the same fashion and have the same properties.

Applicants submit that the Office's assertion with respect to the similarity of properties of compositions having different amounts of polymer is not correct. Applicants draw the Office's attention to the examples of Kinker which demonstrate that (1) the effect of varying the amounts of polymer is not predictable and/or (2) changing the amount of polymer present in the composition substantially impacts the properties of the composition. Examples 1A-10A described in columns 5 and 6 of Kinker are compositions that contain 0.39 wt.% polymer solids (see column 5, line 55). Example 1B is the same composition as Example 1A but instead contains 0.79 wt.% polymer solids (see column 6, lines 18-19). A comparison of

the properties of the Example 1A and 1B compositions is provided in Table 4 of column 6 of Kinker, reproduced below for convenience:

TABLE 4

	Canola Oil	Example 1A	Example 1B
Pour Point (°C)	-24	-33	-33
Kinematic Viscosity (cSt), 40°C	35.95	37.38	38.76
0°C	---	231.2	243.6
-10°C	---	446.2	469.8
-20°C	---	1026	1067
-30°C	---	4239	3938
Brookfield Viscosity (cP), -10°C	---	550	600
-20°C	---	1450	1500
-26°C	Solid	2400	3300
-30°C	Solid	3350	4350
-40°C	Solid	Solid	Solid

Table 4 above provides the viscosity properties of the Example 1A and 1B compositions, it is evident from the data of Table 4 that the kinematic viscosity of the Example 1A compositions is greater than the kinematic viscosity of the Example 1B composition. In contrast, the Brookfield viscosity (e.g., the absolute viscosity) of the Example 1A compositions is lower than the Brookfield viscosity of the Example 1B compositions. The Kinker data above are contradictory and may lead one of ordinary skill in the art to believe that a predictable effect cannot be directly attributed to the amount of polymer present in the prior art compositions.

Thus, the Office's assertion that the properties of a composition containing 5% of polymer solids in comparison to a composition containing 5 wt.% of solids is not correct for at least the reasons (i) based on the disclosure of Kinker one of ordinary skill in the art would not be able to attribute a predictable effect to the amount of polymer and/or (ii) one of ordinary skill in the art would recognize that increasing the amount of the solid polymer changes one of kinematic viscosity and Brookfield viscosity such that the properties of the

resulting compositions are not similar (e.g., the compositions of the resulting compositions have different viscosities).

Applicants submit the Office's assertion is contradictory to the data provided by Kinker and thus the rejection should be withdrawn.

Applicants further submit that the Office's rejection of the present claims based on legal precedent, i.e., *Titanium Metals Corp.*, is legally not correct. As already stated above and as argued previously in the December 10, 2007 Amendment, Kinker does not disclose or suggest a composition having any more than 2 wt.% of polymer whereas the present claims require a minimum of 5 wt.% polymer. In order to arrive at the presently claimed invention based on the disclosure of Kinker, one of ordinary skill in the art would have to more than double the amount of polymer present in the Kinker compositions (i.e., it would be necessary to increase the amount of the Kinker polymer by 150%). *Titanium Metals* does not stand for the proposition that a *prima facie* case of obviousness exists when a prior art range and a claimed range differ by the relative amount of the difference between 2 wt.% and 5 wt.%. In fact, the obviousness determination made by the court in *Titanium Metals* compared a claimed composition having 0.3% Mo and 0.8% Ni with a prior art disclosure of an alloy containing amounts of Mo and Ni in ranges of 0.25%-0.31% Mo and 0.75 - 0.94% Ni. The amount of the Mo component of the claimed invention lay within the 0.25-0.31% Mo range that the court felt was suggested for Mo. Likewise, the 0.8% Ni fell within the 0.75-0.94% Ni range the court felt was suggested by the prior art for Ni. The facts in *Titanium Metals* are substantially different from the facts in the present case. The 0.3% Mo component of the appealed claims were, at the greatest, only 20% greater than the minimum amount of Mo disclosed in the prior art. Likewise, the 0.8% of Ni of the appealed claims were less than 10% greater than the minimum amount of Ni in the prior art composition.

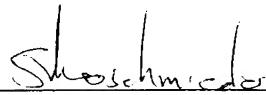
As stated above, the maximum amount of the polymer solids of the Kinker compositions is 2% by weight. The minimum amount of polymer in the claimed compositions is 5% by weight. The amount of polymer in Kinker must be increased by 150% in order to arrive at the presently claimed invention. *Titanium Metals* nowhere addresses or discusses a factual situation in which it is necessary to more than double a prior art amount in order to fall within a claimed range.

Applicants submit that the rejection of the present claims in view of the combination of Roos with Kinker or the combination of Mottus with Kinker is legally not correct at least because the Office has not established a *prima facie* case of obviousness on the ground that (i) there is a substantial difference in the maximum amount of polymer of Kinker and the minimum amount presently claimed and (ii) the data of Kinker provide evidence that those of ordinary skill in the art would not have expected the properties of the presently claimed invention to be the same as the properties of the Kinker compositions.

For the reasons discussed above in detail, Applicants submit that all now-pending claims are in condition for allowance. Applicants request withdrawal of the rejection and the mailing of a Notice of Allowance acknowledging the patentability of the presently claimed subject matter.

Respectfully submitted,

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